

July 28, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Reiman Publications, LLC

v.

Farm Living, Inc.

Opposition No. 91150075 to Application
Serial No. 76026184 filed April 13, 2000

Marta S. Levine of Quarles & Brady for Reiman Publications,
LLC.

Robert M. Schwartz for Farm Living, Inc.

Before Hanak, Quinn and Holtzman, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Farm Living, Inc. (applicant) seeks to register in
typed drawing form FARM LIVING for "publications, namely, a
magazine featuring homes, barns, land, fences, furnishings,
gardening, food, entertaining, decorating, arts, antiques,
architecture, real estate, travel, events, construction,
and general lifestyle; catalogs in the field of products
for the home and farm." (Class 16). The intent-to-use
application was filed on April 13, 2000.

Reiman Publications, LLC (opposer) filed a timely Notice of Opposition alleging that since March 1978 it has continuously published a magazine under the mark FARM & RANCH LIVING, and that it owns Registration No. 1,198,664 for this mark for "periodically published magazine." Continuing, opposer alleged that applicant's mark FARM LIVING so resembles opposer's mark FARM & RANCH LIVING such that applicant's mark, if used, would be likely "to cause confusion and to cause mistake and to deceive." (Notice of Opposition paragraph 7). While opposer did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for the Notice of Opposition.

Applicant filed an answer which denied the pertinent allegations of the Notice of Opposition. Opposer and applicant filed briefs. An oral hearing was held before this Board on May 18, 2004 at which counsel for both parties were present.

The record in this case is described at pages 1 and 2 of opposer's brief and at pages 2 and 3 of applicant's brief. It consists, in part, of opposer's Registration No. 1,198,664 for FARM & RANCH LIVING for "periodically published magazine," as well as the depositions of Jeffrey Anderson (opposer's chief financial officer), Judith A.

Wolf (opposer's accounting manager) and Jack Thomason (applicant's founder).

At the outset, we note that priority of use rests with opposer and applicant does not contend to the contrary. The record reflects that opposer has made continuous use since 1978 of its mark FARM & RANCH LIVING for a magazine. Moreover, priority also rests with opposer based upon the fact that it is properly made of record its Registration No. 1,198,664 for the mark FARM & RANCH LIVING for a "periodically published magazine." 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 19:9 at page 19-18 (4th ed. 2002).

We will now begin our likelihood of confusion analysis. In any such analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, they are legally identical. Opposer's registration for FARM & RANCH LIVING covers periodically published magazines of all types. This

very broad definition of opposer's goods covers the more specialized definition of applicant's magazine which will feature, among other things, homes, barns, land and farms.

Applicant's founder Mr. Thomason testified that applicant's magazine would be different from opposer's magazine because applicant's magazine would contain advertising whereas opposer's magazine does not (Thomason deposition page 19); because applicant's magazine would have larger dimensions than opposer's magazine (Thomason deposition page 20); because applicant's magazine would have a different trade dress than opposer's magazine (Thomason deposition page 20); and because applicant's magazine would have more pages than opposer's magazine (Thomason deposition page 21).

Even assuming for the sake of argument that Mr. Thomason's prediction as to the actual differences in the two magazines proves correct, such purported actual differences are irrelevant in Board proceedings. It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in opposer's registration rather than what the evidence shows the goods and/or

services to be.” Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Considering next the marks, we note at the outset that when the goods are legally identical, as is the case here, “the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.”

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Obviously, both marks share the same first and last word. This causes the marks to be similar in terms of both appearance and pronunciation. Moreover, in terms of connotation the marks are extremely similar. In this regard we take judicial notice of the fact that the word “ranch” is defined as follows: “A large farm, esp. in western States.” Webster’s New World Dictionary (2d ed. 1975).

If applicant were to use its mark FARM LIVING, and later a consumer was to see opposer’s mark FARM & RANCH LIVING, he could easily assume that the two magazines were related, or that the publishers of FARM LIVING had renamed their magazine to FARM & RANCH LIVING to make it clear that the magazine also covered large western farms (ranches). This is particularly true given that, as stated by Mr. Thomason, “the time someone spends in or at a newsstand is

very limited in that it's very likely that the decision [to purchase a magazine] is an impulse decision." (Thomason deposition pages 23-24.). Indeed, even Mr. Thomason, applicant's founder, conceded that "Farm Living is a name that is similar to Farm and Ranch Living." (Thomason deposition page 31). It is true that Mr. Thomason qualified his answer by noting that there are a number of publications which contain in their titles the words "farm" or "living." However, Mr. Thomason also noted that despite an exhaustive search of magazine titles, applicant could find no other magazine whose title contained both the words "farm" and "living." (Thomason deposition page 33).

Given the fact that opposer's goods and applicant's goods are legally identical and the additional fact that opposer's mark and applicant's mark are very similar, we find that if applicant were to use its mark FARM LIVING there would be confusion with opposer's mark FARM & RANCH LIVING.

While we have no doubt about our conclusion as to likelihood of confusion, it should be pointed out that both in the registration for FARM & RANCH LIVING and the application for FARM LIVING the marks are depicted in typed drawing form. This means that the application and registration are "not limited to the mark[s] depicted in

any special form," and hence we are mandated "to visualize what other forms the mark[s] might appear in." Phillips Petroleum Co. v. C.J. Webb Inc., 442 F.2d 1376, 170 USPQ, 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992).

If both opposer's mark FARM & RANCH LIVING and applicant's mark FARM LIVING were to be depicted in a similar manner, then we think that confusion would not be merely likely, but that it would be inevitable. In this regard, applicant's founder Mr. Jacobsen conceded that if applicant in its presentation of FARM LIVING "were to mirror Farm and Ranch Living, then of course there is the potential for confusion." (Jacobsen deposition page 48).

Two final points need to be discussed. First, applicant presented numerous copies of magazine covers whose titles included the words "farm" or "living." Three comments are in order. First, as previously noted, applicant did not make of record a single third-party publication whose title included both the words "farm" and "living." Second, a review of applicant's third-party magazine titles demonstrates that not one of the titles is remotely similar to either opposer's magazine title or applicant's proposed magazine title. Some of the titles made of record by applicant include Western Farm Press,

Farm Equipment, Alaska Living and Sea Ray Living. Third, applicant presented absolutely no evidence showing the level of circulation of any of these purported third-party magazines. It is well settled that "in the absence of any evidence showing the extent of use of any such marks or whether any of them are now in use," said third-party marks provide no basis for saying that the marks have had, or may have, any effect on the public mind so as to have a bearing on likelihood of confusion. Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (original emphasis).

As an aside to the foregoing, applicant also made of record fifteen sets of third-party registrations for marks not containing the words "farm" or "ranch," but merely containing a common word or words. One example of a set are registrations for ART & ANTIQUES and for THE MAGAZINE ANTIQUES. We do not see what bearing these third-party registrations have on the issue of likelihood of confusion between the marks FARM & RANCH LIVING and FARM LIVING in that all of these registered marks are extremely dissimilar from opposer's mark and applicant's mark. To the extent that applicant may be arguing that in the past Examining Attorneys have allowed similar marks to be registered for magazine titles, we simply note that it is well settled as

a matter of law that "the PTO's allowance of such prior registrations does not bind this Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

The second point to be made is that opposer has argued that its mark FARM & RANCH LIVING is a famous mark and "is therefore entitled to a broad scope of protection." (Opposer's brief page 6). Applicant has objected on various grounds "to the admissibility of any exhibits ... which purport to reflect opposer's FARM & RANCH LIVING magazine sales." (Applicant's brief page 2). We will not rule on applicant's objection because even if we were to consider the sales of opposer's magazine FARM & RANCH LIVING, we would find that such sales figures do not qualify said mark as being even remotely famous. Opposer's evidence establishes that its current circulation of FARM & RANCH LIVING is 430,000. This circulation figure does not show that opposer's mark is famous. Moreover, opposer did not present other evidence, such as third-party testimony, showing its mark to be famous. Thus, opposer has not proven its mark to be famous. Therefore, we need not rule upon applicant's objection.

Decision: The opposition is sustained.